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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/638,554 | 08/12/2003 | Teresa S. Healy | GRAY033/00US | 5392 |
| 22903 | 7590 | 07/14/2005 | EXAMINER | |
| COOLEY GODWARD LLP ATTN: PATENT GROUP 11951 FREEDOM DRIVE, SUITE 1700 ONE FREEDOM SQUARE- RESTON TOWN CENTER RESTON, VA 20190-5061 | | | MORAN, KATHERINE M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3765 | |

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

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|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/638,554 | Applicant(s) HEALY ET AL. | |
| | Examiner Katherine Moran | Art Unit 3765 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-27 and 30-33 is/are allowed.
- 6) ☒ Claim(s) 1-11, 14-16, 20, 28, 29 is/are rejected.
- 7) ☒ Claim(s) 12, 13, 17-19 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1-11-05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 1/11/05 was filed after the mailing date of the application submission on 8/12/03. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 2 recites that the membrane has a movable portion and a fixed portion.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-11, 15, 16, 20, 28, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by LeGette et al. (LeGette, U.S. 6,332,223). LeGette discloses the invention as claimed. LeGette teaches an ear warmer comprising a cover 200 having an outer member 130 and an inner member in the form of first ear portion 100, second ear portion 110, and a middle portion 120 extending between the first and second ear portions. The outer and inner members define an interior region therebetween, and a frame 300 with at least a portion of the frame being disposed in the interior region defined by the outer and inner members, and a membrane coupled to the cover, the membrane and inner member forming a receptacle configured to receive at least a portion of an ear of a user. Frame 300 is configured to extend around a back of a head of the user. The membrane is coupled to a portion of one of the first and second ear portions along a perimeter of the ear portion, the portion of the perimeter is less than the entire perimeter of the ear portion. Figure 9 shows an alternative embodiment with membranes 402,412 disposed with the interior of the ear warmer shell. LeGette also discloses an embodiment with first and second pocket membranes 600 and 610 which are attached to the inner member of the cover, along the perimeter of the outer membrane 130 to form respective pockets into which a frame member can be inserted. The membrane has a movable portion (the unattached perimeter) and a fixed portion

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(stitched area) and a deployed configuration and retracted configuration, the movable portion of the membrane being disposed adjacent the inner member when the membrane is in its deployed configuration, at least a portion of the movable portion of the membrane being disposed adjacent the outer member when the membrane is in its retracted configuration. Regarding claim 16, the frame inherently applies a compression force to the wearer's head when worn, due to the frame's frusto-conical shape, and the membrane inherently applies a friction force against the wearer's head as well as the frame, to secure the ear warmer to the wearer's head. With regard to claim 20, the frame has a deployed configuration and a collapsed configuration in that the frame as recited in column 4, lines 5-17 teach a slidably adjustable band 320 such that the frame takes on a deployed and collapsed configuration depending on how the band is adjusted. Given that the membrane is attached to the frame, the membrane takes on the configuration of the frame. The method steps of claims 28 and 29 are inherent in the device taught by LeGette.

5. Claims 1, 8, 11, 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Isom et al. (Isom, U.S. 6,735,784). The applied reference has a common inventor (Alan Tipp) with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

6. Isom discloses the invention as claimed. Isom teaches an ear warmer comprising a cover 10 having an outer member 160 and an inner member 150, the outer member and inner member defining an interior region therebetween, a frame 200 configured to extend around a back of a head of the user, at least a portion of the frame being disposed in the interior region defined by the outer member and the inner member, and a membrane coupled to the cover, the membrane and inner member of the cover forming a receptacle configured to receive at least a portion of an ear of a user. The membrane is coupled to the inner member of the cover. Column 5, lines 13-20 recite that the membrane portions may take on various configurations. The frame has a first ear portion 220, second ear portion 230, and a band 210 extending between the first and second ear portions, a cover member coupled to the frame such that at least a portion of the first ear portion is covered by the cover member, and a membrane coupled to at least one of the cover member and the frame, the membrane and cover member forming a receptacle configured to receive at least a portion of an ear of a user. Regarding claim 14, the ear warmer includes first and second cover members, first and second membranes, and first and second receptacles. Regarding claim 16, the frame inherently applies a compression force to the wearer's head when worn, due to the frame's frusto-conical shape, and the membrane inherently applies a friction force against the wearer's head as well as the frame, to secure the ear warmer to the wearer's head.

Allowable Subject Matter

7. Claims 22-27 and 30-33 are allowed.
8. Claims 12, 13, 17-19, and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. The prior art made of record on the attached PTO-892, and not relied upon, is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications should be directed to Primary Examiner Katherine Moran at (571) 272-4990. The examiner can be reached on Monday-Thursday from 8:30 am to 6:00 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert, may be reached at (571) 272-4983. The official and after final fax number for the organization where this application is assigned is (703) 872-9306. General information regarding this application may be obtained by contacting the Group Receptionist at (571) 272-3700.

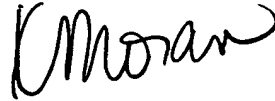
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kmm

July 6, 2005

A handwritten signature in black ink, appearing to read "K Moran", with a stylized flourish at the end.

Katherine Moran

Primary Examiner, AU 3765